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REMARKS/ARGUMENTS

In the latest Official Action, which is dated November 25, 2003, the Examiner has withdrawn all of the rejections set forth in the Official Action of August 19, 2003, and issued a new final rejection based primarily on two newly cited documents.

The Examiner's rationale for designating the latest rejection as "final" is set forth in Paragraph 12 of the Action. Specifically, the Examiner has stated that applicant's amendment necessitated the new ground of rejection. However, this rationale cannot be sustained, since the Response filed on October 21, 2003 presented no amendments to either the specification or claims. Accordingly, it is submitted that the finality of the latest rejection should be withdrawn and the present amendment should be entered and fully considered.

The entry of the present amendment and reconsideration of the rejections are also justified under 37 CFR 1.116 since the present amendment involves only the cancellation of the prior Claims 1-3. No new issues are presented.

Turning now to the merits of the rejections, Claims 5, 7-8, 10-11, and 13 were rejected as being unpatentable over a proposed combination of Mowry '348 and Frölich '990. These claims are directed to a method and apparatus for applying printed text, such as an address label, on an exposed border region of each of a plurality of printed products as they are conveyed along a path of travel in an overlapping imbricated stream. The text is applied by printing a partially transparent contrast panel onto the exposed border region of each printed product, using for example a partially transparent white ink, note page 6, lines 20-23 of the

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specification of the present application. The text is then formed within or on each contrast panel, such as by printing the contrast panel or forming blank areas within the contrast panel.

The phrase "partially transparent contrast panel" is defined in the specification and claims as forming a good contrast with the information formed thereon and also allowing the underlying printed information to be seen and read, note particularly the paragraph beginning at page 3, line 32, and the paragraph beginning at page 6, line 16 of the specification. Also, Figure 2 illustrates a partially transparent contrast panel at 14, and as indicated the underlying printed information 10' can be seen therethrough, and the printed text 18 on the panel is clearly visible.

Base method Claim 8 is specific to an embodiment wherein the step of applying the partially transparent contrast panel to the exposed border region of each printed product, involves printing the contrast panel so as to overlie the printing on the printed surface of the product and so as to allow the printing on the printed surface to be seen therethrough.

Independent apparatus Claim 11 defines the invention with similar terminology, and it further specifically recites a conveyor system 24 for conveying the printed products 10 in an overlapping imbricated stream, and as seen in Fig. 3, a label printing means 28 for printing the partially transparent contrast panels 14 as defined above to the exposed border region of each product.

The subject matter of the cited prior patent to Mowry relates to the design of a financial document and as such it is non-analogous to a system for applying labels to each of series of printed products being conveyed in an imbricated stream as disclosed by Frölich. The references themselves do

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not suggest any reason for the proposed combination, and for that reason the rejection cannot be sustained.

More particularly, Mowry concerns a financial document, i.e. a check or a money order, which is protected against alteration. The product comprises an amount receiving area 20 and an area 26 for carrying a message. Both areas 20 and 26 are coated with layers 50 and 52 of self-contained pressure sensitive image forming chemicals. The chemicals are released from frangible capsules (column 1, lines 59-65) upon application of pressure of a printer, then react and form the printed numerals and characters in the areas 20 and 26. As illustrated by Fig. 3, the "ink" (formed by the reaction of the chemicals) is black and fully covers the words "Dollars" in the area 20. In the area where the printing "pay only" or the field forming the numeral 8 appears, the underlying printing "Dollars" cannot be seen through. Consequently, there is no partially transparent contrast panel bearing information and allowing an underlying printing to be seen therethrough.

Furthermore, there is no hint at all to apply the printing to the financial product of Mowry while conveying the product in an imbricated formation. To the contrary, the skilled person would surely refrain from doing so, since the financial product contains the pressure sensitive frangible capsules which contain the ink forming chemicals. Therefore, applying such printing in an imbricated formation would likely result in alteration of the information contained in the areas 20 or 26 of the neighboring overlapping products as well, which has to be avoided by all means. Further, a skilled person would not convey these products in an imbricated stream, since these financial products require careful handling, are used one by one and are not mass products.

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Therefore, the skilled person would not seek to combine the teaching of Mowry with that of Fröhlich. Also, since Mowry does not disclose a partially transparent contrast panel, even a combination of the two patents does not lead to the invention as recited in Claim 5 or 8.

Dependent Claims 6, 9, and 12 were rejected as being unpatentable over Mowry and Fröhlich as applied above, and further in view of Gurwick. Gurwick was applied in view of its teaching of printing information onto a panel, but the patent fails to supply the deficiencies of the combination of Mowry and Fröhlich as set forth above. Similarly, the prior patent to Reist was applied to reject dependent Claim 14, but Reist also fails to supply the above noted deficiencies of Mowry and Fröhlich.

Claims 5-13 were also rejected as being unpatentable over "A Century of Comics" (as discussed in the article entitled "1933: The First Comic Book") in view of Fröhlich. Also, in connection with this rejection, the Examiner has referred to the article "Understanding Color" for a description of four color printing.

It is not clear as to when the comic book "Century of Comics" was published, or when the "Understanding Color" article was published. However, assuming arguendo that the comic book and article are prior art under the patent statute, it may be said that the comic book and article have nothing whatever to do with a process and apparatus for applying text on each of a plurality of printed products as they are conveyed in an imbricated stream.

"A Century of Comics" refers to the four color printing process and shows cover pages of comic books with a title and some illustrations. The title is either printed in black on a

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uniform (presumably colored) background (page 1, upper title page: the title is printed on a balloon appearing grey in our copy) or has a uniform black background (page 1, lower title page). In both cases there is no underlying printing of the area of the title that can be seen through. Referring to the lower image, the background is black. There is thus no hint of a partially transparent contrast panel that forms a good contrast to the printed information and allows the printing to be seen through. Referring to the upper image, the background is uniform and lighter than black. There is also no contrast panel having an underlying printing which can be seen through the contrast panel. Furthermore, there is no hint to convey these products in an imbricated formation while applying the contrast panel.

The present invention starts where "A Century of Comics" ends. The invention teaches that a completed printed product (e.g. a comic book as shown in "A Century of Comics", printed by whatever method) is furnished with a contrast panel applied to the border region of the already finished product, while conveying it in an imbricated formation. Applying a contrast panel in this way is not at all possible while making the "Comics" cover page itself. A four color printing is done using a rotary printing press, which requires feeding of single sheets of paper, but such a press is not able to print on products which are conveyed in an imbricated stream. Therefore, there is no motivation at all to combine "A Century of Comics" with Fröhlich, and in fact this would appear to be technically impossible.

Generally, it seems to be rather unrealistic to identify a "first layer of colored printing of the printed balloon" of the upper title page with the printing of the invention, a "second layer of colored printing of the balloon" with the

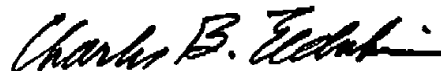
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contrast panel and the title with the information on the contrast panel. A skilled person would have never made this analysis of the prior art on the priority date of the present application, especially since these "layers" are not even disclosed by "A Century of Comics".

To summarize, neither Mowry nor "A Century of Comics" discloses or suggests printing a partially transparent contrast panel onto a border region of the product and forming information on the contrast panel so that the information can be easily seen and read, as claimed in Claims 5 and 8. Furthermore, these documents do not disclose or give motivation to convey the products in an imbricated stream while printing the contrast panel, as also claimed in Claims 5 and 8. As discussed above, the skilled person would refrain from using such a conveying method while printing the contrast panel, because it is technically impossible (in the case of "A Century of Comics") or would lead to unacceptable printing results (in the case of Mowry). The prior art also does not disclose or suggest printing the contrast panel on a border region of the printed product which has a printing thereon, as further claimed in Claim 8. Furthermore, an apparatus having the features of Claim 11 is neither disclosed nor rendered obvious by the cited prior art for the same reasons as already discussed.

For the reasons set forth above, it is respectfully submitted that the pending claims are allowable over the art of record, and such action is solicited.

Respectfully submitted,



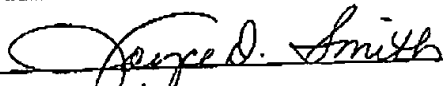
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